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09/804,038	03/13/2001	Minoru Saito	1405.1037	8843

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EXAMINER

TOMASZEWSKI, MICHAEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/804,038	SAITO ET AL.	
	Examiner	Art Unit	
	Mike Tomaszewski	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 7/28/06. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/28/06 has been entered. Claims 1, 6 and 7 have been amended. Claims 1-7 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkman et al. (6,697,783; hereinafter Brinkman), in view of Tsai (6,038,566; hereinafter Tsai), in view of Sato et al. (5,911,687; hereinafter Sato) and in view of Joao (6,283,761; hereinafter Joao).

(A) As per currently amended claim 1, Brinkman discloses a health-care information system comprising:

- (1) referee hospital information storage means for storing hospital information including diagnostic-care department information, information on doctors (Brinkman: col. 4, lines 27-35; col. 6, lines 63-67; col. 7, lines 26-39);
- (2) examination information acceptance means for accepting patient information from referrer medical institutions as patient referral sources (Brinkman: col. 4, lines 27-35; col. 6, lines 63-67; col. 7, lines 41-50);
- (3) referee hospital information presentation means for referring appropriate referee medical institutions from said referee hospital information storage means to said referrer medical institution based on examination information accepted by said examination information acceptance means, and for presenting hospital information on the referee medical institution to said referrer medical institution (Brinkman: col. 11, lines 1-18 and col. 11, lines 47-56);

- (4) referral deciding means for accepting decisions on referee medical institutions from said referrer medical institutions ((Brinkman: Fig. 21B-Fig.22; Note that Examiner considers the “check-box” within the graphical user interface (GUI) a means of referral acceptance – see Fig. 21B. Moreover, the GUI of Fig. 22 provides for additional means of referral acceptance via the “Referrals:” entry-line, “Customer Decision” drop-down-box and the “Follow-up Assignment:” entry-line.));
- (5) patient referral information presentation means for creating patient referral information based on patient information accepted by said examination information acceptance means (Brinkman: Fig. 21B and Fig. 22), and for sending said patient referral information to the referee medical institutions decided upon by said referral deciding means ((Brinkman: col. 11, lines 54-56; Note that the GUI of Fig. 21B provides for faxing as one means of sending referral information to a designated recipient (e.g., referee).)); and
- (6) electronic patient chart preparation means for preparing electronic patient charts based on patient information accepted by said patient information acceptance means (Brinkman: col. 11, lines 57-67; col. 12, lines 1-3; fig. 14-23).

Brinkman, however, fails to *expressly* disclose a health-care information system comprising:

- (7) storing hospital map information on referee medical institutions as patient referral destinations;
- (8) wherein said electronic patient charts are also prepared or updated at said referee medical institutions based on said referral information from said referrer medical institutions; and
- (9) automatically referring.

Nevertheless, these features are old and well known in the art, as evidenced by Tsai, Joao and Sato.

In particular, Tsai, Joao and Sato disclose a health-care information system comprising:

- (7) storing hospital map information on referee medical institutions as patient referral destinations (Tsai: col. 8, lines 44-67; col. 9, lines 1-41; Fig. 14-15 and Fig. 18-19); and
- (8) wherein said electronic patient charts (Joao: abstract; col. 4, lines 26-40; col. 12, line 21-col. 15, line 5; col. 6, lines 5-37; col. 18, lines 21-44; col. 20, lines 21-27; fig. 1) are also prepared or updated at said referee medical institutions based on said referral information from said referrer medical institutions (Sato: abstract; col. 5, lines 33-58; fig. 1-21); and

- (9) automatically referring (Joao: col. 7, lines 34-42; Examiner notes that Joao teaches that any functions (e.g., referring, etc.) can be activated automatically and that information can be transmitted to and/or from any of the respective parties (e.g., referrer, referee, etc.).

Examiner also notes that Joao teaches a comprehensive healthcare information system and method encompassing a plethora of embodiments involving, *inter alia*, virtually all healthcare-related participants, services, processes, products and information (Joao: abstract; col. 4, lines 26-40; col. 6, lines 5-37; col. 12, line 21-col. 15, line 5; fig. 1).

For example, Joao teaches a system and method which incorporates information from any combination and/or all of the participants (e.g., referees, referrers, providers, intermediaries, payers, patients, users, hospitals, physicians, *etc.*) in the healthcare field. Joao further teaches an extensive communication network between the various healthcare-related participants whereby information (e.g., referral information, hospital information, patient examination information, *etc.*) can be transmitted multi-directionally to the various healthcare-related participants. Joao still further teaches that any healthcare-related participant may utilize the present invention in the same, similar and/or analogous manner (e.g., a primary hospital, secondary hospital, physician, intermediary, *et alia*, can be designated as the referrer medical institution, *etc.*).

Moreover, Joao teaches that the system and method can be utilized by any healthcare-related participant (e.g., referrer hospital, *etc.*) in order to find and/or locate

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any other healthcare-related participant (e.g., referee hospital) for various healthcare-related purposes (e.g., patient treatment, *etc.*).

As such, Examiner respectfully submits that the teachings of Brinkman, Tsai, Joao and Sato, *in toto*, render all permutations relating to which particular entity is, *inter alia*, accepting, receiving, and/or sending the referral information obvious.

One having ordinary skill would have found it obvious at the time of the invention to combine the teachings of Tsai with the combined teachings of Brinkman, Joao, Sato and with the motivation of storing more comprehensive referral information and thereby enhancing the decision support system that provides health advice that is directly tailored to member-specific needs (e.g., advising patients on the locations of potential referees, *etc.*) (Brinkman: col. 4, lines 10-12).

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Brinkman, Tsai and Sato with the motivation of facilitating the creation, management, quality, efficiency and effectiveness of healthcare services (Joao: col. 2, lines 38-54).

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the teachings of Sato with the combined teachings of Brinkman, Joao and Tsai with the motivation of providing a means for selecting an appropriate physician based on patient needs (Sato: abstract).

(B) As per previously presented claim 2, Brinkman discloses the health-care information system set forth in claim 1, further comprising:

- (1) referral creation means for creating letters of reference based on information input from said patient referral sources (Brinkman: col. 12, lines 4-18; Figs. 7 and 11); wherein
 - (2) said patient referral information presentation means transmits to said referee medical institutions patient referral information including said electronic patient charts created by said electronic patient chart creation means attached to letters of reference created by said referral creation means (Brinkman: col. 12, lines 4-18; Figs. 7 and 11; Examiner has taken into account that Brinkman teaches a broad array of entities utilizing the Brinkman system including referrers and referees (Brinkman: col. 7, lines 12-20).
- (C) As per original claim 3, Brinkman discloses the health-care information system as set forth in claim 1, said patient referral information presentation means comprising:
- (1) reply method selection means for having said referrer medical institutions select a reply method when at said referee medical institutions diagnostic results and diagnostic information including prescriptions is to be sent from said referee medical institutions to said referrer medical institutions ((Brinkman: col. 12, lines 4-28; Figs. 21B-23; Insofar as the Brinkman system is capable of accommodating a variety of reply methods (i.e., fax,

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e-mail, telephone, etc.), a user, in order to select a desired reply method, need only make the appropriate request in the graphical user interface's comment box (i.e., reply method selection means.)); wherein

- (2) said patient referral information presentation means sends to said referee medical institutions information on the reply method selected by said reply method selection means, attached to said patient referral information (Brinkman: col. 12, lines 4-28; Figs. 7, 11, and 21B-23).

(D) As per original claim 4, Brinkman fails to *expressly* disclose the health-care information system as set forth in claim 1, further comprising:

- (1) appointment information presentation means for presenting to said referrer medical institutions scheduling conditions for said referee medical institutions;
- (2) appointment acceptance means for having said referrer medical institution decide on dates and times for appointments at said referee medical institution; and
- (3) appointment finalization means for finalizing appointments by sending to said referrer medical institutions the appointment dates and times accepted by said appointment acceptance means.

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Nevertheless, these features are old and well known in the art, as evidenced by Joao.

In particular, Joao discloses the health-care information system as set forth in claim 1, further comprising:

- (1) appointment information presentation means for presenting to said referrer medical institutions scheduling conditions for said referee medical institutions (Joao: col. 32, lines 47-67);
- (2) appointment acceptance means for having said referrer medical institution decide on dates and times for appointments at said referee medical institution (Joao: col. 32, line 64 to col. 33, line14); and
- (3) appointment finalization means for finalizing appointments by sending to said referrer medical institutions the appointment dates and times accepted by said appointment acceptance means (Joao: col. 33, lines 15-25).

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Brinkman, Tsai and Sato with the motivation of facilitating the creation, management, quality, efficiency and effectiveness of healthcare services (Joao: col. 2, lines 38-54).

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(E) As per original claim 5, Brinkman discloses the health-care information system as set forth in claim 4, wherein said appointment information presentation means comprises appointment information storage means for acquiring and storing appointment conditions for said referee medical institutions (Brinkman: col. 11, line 43-46; Note that Examiner considers appointment conditions to read on “rules associated with referring members to specific physicians.”).

Moreover, Examiner considers a “scheduling information” to read on appointment conditions—that is, scheduling an appointment is conditioned on selecting a time slot within the predetermined time availability of physician(s) at a particular medical institution (Joao: col. 32, lines 53-67).

4. Currently amended claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkman, in view of Joao and Sato.

(A) As per claim 6, Brinkman discloses a method of providing health-care information, comprising:

- (1) storing hospital information on referee medical institutions (Brinkman: col. 4, lines 27-35; col. 6, lines 63-67); and
- (2) accepting patient information from a referrer medical institution as a patient referral source (Brinkman: col. 4, lines 27-35; col. 6, lines 63-67).

Brinkman, however, fails to *expressly* disclose a method of providing health-care information, comprising:

- (3) automatically referring appropriate referee medical institutions to said referrer medical institution based on said patient information;
- (4) presenting hospital information associated with the referee medical institutions to said referrer medical institution;
- (5) accepting decisions on referee medical institutions from said referrer medical institution;
- (6) creating patient referral information based on said patient information; and
- (7) sending said patient referral information to the referee medical institutions.

Nevertheless, these features are old and well known in the art, as evidenced by Joao and Sato. In particular, Joao and Sato disclose a method of providing health-care information, comprising:

- (3) automatically referring (Joao: col. 7, lines 34-42; Examiner notes that Joao teaches that any functions (e.g., referring, etc.) can be activated automatically and that information can be transmitted to and/or from any of the respective parties (e.g., referrer, referee, etc.)) appropriate referee

- medical institutions to said referrer medical institution based on said patient information (Sato: abstract; col. 5, lines 33-58; fig. 1-21);
- (4) presenting hospital information associated with the referee medical institutions to said referrer medical institution (Sato: abstract; col. 5, lines 33-58; fig. 1-21);
 - (5) accepting decisions on referee medical institutions from said referrer medical institution (Sato: abstract; col. 5, lines 33-58; fig. 1-21);
 - (6) creating patient referral information based on said patient information (Sato: abstract; col. 5, lines 33-58; fig. 1-21); and
 - (7) sending said patient referral information to the referee medical institutions (Joao: abstract; col. 4, lines 26-40; col. 6, lines 5-37; col. 12, line 21-col. 15, line 5; fig. 1).

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the teachings of Joao with the combined teachings of Brinkman and Sato with the motivation of facilitating the creation, management, quality, efficiency and effectiveness of healthcare services (Joao: col. 2, lines 38-54).

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the teachings of Sato with the combined teachings of Brinkman Joao with the motivation of providing a means for selecting an appropriate physician based on patient needs (Sato: abstract).

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brinkman, in view of Joao.

(A) As per currently amended claim 7, Brinkman discloses a method of providing health-care information, comprising:

- (1) accepting patient examination information from a referrer medical institution as a patient referral source (Brinkman: abstract; col. 11, lines 39-col. 12, line 19; Fig. 7 and 21a-b); and
- (2) referring appropriate referee medical institutions to said referrer medical institution based on said patient examination information (Brinkman: abstract; col. 11, lines 1-18 and lines 47-56).

Brinkman, however, fails to *expressly* disclose a method of providing health-care information, comprising:

- (3) automatically referring.

Nevertheless, these features are old and well known in the art, as evidenced by Joao. In particular, Joao discloses a method of providing health-care information, comprising:

- (3) automatically referring (Joao: col. 7, lines 34-42; Examiner notes that Joao teaches that any functions (e.g., referring, etc.) can be activated automatically and that information can be transmitted to and/or from any of the respective parties (e.g., referrer, referee, etc.).

One of ordinary skill in the art would have found it obvious at the time of the invention to combine the teachings of Joao with the teachings of Brinkman with the motivation of facilitating the creation, management, quality, efficiency and effectiveness of healthcare services (Joao: col. 2, lines 38-54).

Response to Arguments

6. Applicant's arguments filed 7/28/06 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 7/28/06.

(A) On page 6 of the 7/28/06 response, Applicant argues that Brinkman neither teaches, discloses, nor suggests, "automatically referring appropriate referee medical institutions to said referrer medical institution based on said patient examination information," as recited in claim 7.

In response, Examiner respectfully submits that the combined teachings of Brinkman and Joao, *in toto*, do indeed teach, disclose and suggest the aforementioned features. For example, Brinkman teaches generating referrals (i.e., referring) and transferring a caller to a different operator, such as a pharmacist (i.e., referring) (Brinkman: abstract; col. 11, lines 22-24). Moreover, the Brinkman referral system (i.e., referrer) prompts the operator (i.e., referrer) to enter a geographic location and/or other information (e.g., patient symptoms/condition) and subsequently the Brinkman referral system provides a list of providers (i.e., referee medical institutions) or specific physicians (Brinkman: col. 11, lines 47-56), ergo the system is providing the most appropriate referrals.

As per the amended features of “automatically referring” and “to said referrer medical institution,” Examiner notes that Joao teaches, discloses and suggests that any functions (e.g., referring, etc.) can be activated automatically; that information can be transmitted to and/or from any of the respective parties (e.g., referrer, referee, etc.); that any respective party (e.g., provider, patient, operator, intermediary, referrer, referee, etc.) can utilize the system in the same, similar and/or analogous manner (e.g., any respective party can provide referrals, be referred, etc.) (Joao: col. 7, lines 34-42). Examiner also notes that Brinkman teaches automating various features as well and therefore, strongly suggests automating other features, such as “referring” (See Brinkman: col. 11, lines 57-67).

In short, Examiner respectfully submits that Applicant's aforementioned claim limitations are rendered obvious over a broad, yet reasonable, interpretation of the combined teachings of Joao and Brinkman.

(B) On page 7 of the 7/28/06 response, Applicant argues neither Tsai, Sato, nor Joao teach, disclose, nor suggest "automatically referring appropriate referee medical institutions based on examination information," and therefore, none of these references can make up for the deficiencies of Brinkman with respect to claim 1. Applicant further argues neither Tsai, Sato, nor Joao mentions referrals at all.

First, Examiner respectfully submits that the combined teachings of Brinkman and Joao do indeed teach, disclose, and suggest the limitations of claim 7, as discussed in section 6. (A), *supra*, and therefore, Tsai, Sato, and Joao can make up for any deficiencies of Brinkman with respect to claim 1.

Second, Brinkman, Sato and Joao do, in fact, mention referrals. For example, Brinkman teaches, "generating referrals" (Brinkman: abstract); Sato mentions, "the system searches the doctor database on the basis of patient information including the condition...[and] selects the corresponding doctor" (i.e., makes a referral) (Sato: abstract); and Joao mentions, "the present invention can also be utilized in order to find and/or locate providers...for various healthcare treatments" (i.e., to make referrals) (Joao: col. 6, lines 5-9).

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(C) On page 7-8 of the 7/28/06 response, Applicant argues neither Brinkman, Tsai, Sato, nor Joao teach, disclose, or suggest, “electronic patient charts are also prepared or updated at said referee medical institutions based on said referral information from said referrer medical institutions.”

In response, Examiner respectfully submits that the combined teaches of Brinkman, Tsai, Sato and Joao do indeed teach the aforementioned limitation of claim 1, as discussed in section 3. (A), *supra*. For example, Brinkman teaches, “the system may automatically update the caller's record” (e.g., update referrals provided, etc.) (Brinkman: col. 11, line 57-col. 12, line 4).

(D) Applicant's remaining arguments on pages 7-9 of the 7/28/06 response rely upon or re-hash the issues addressed above and therefore, are moot in view of the responses given in sections 6. (A) – (C), *supra*.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT



Robert Morgan
Robert Morgan
Patent Examiner
Art Unit 3626